

REMARKS

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested.

Status of the Claims

Claims 1 and 2 have been herein amended.

Claims 3-11 were previously canceled without prejudice or disclaimer of the subject matter recited therein, with claims 7-11 having been canceled for being drawn to provisionally non-elected subject matter.

No new matter has been added.

Claims 1 and 2 are now pending in the application.

Claim Objections

Claims 1 and 2 were objected to for being not readily understood. Specifically, the Examiner indicates that the recitation of “with chromium enriched on their surfaces” is not readily understood. In response, claims 1 and 2 have been amended to address to objection. Withdrawal of the objection to claims 1 and 2 is respectfully requested.

Rejections under 35 U.S.C. §103

Claim 1 was rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,506,071 to Tanaka et al. (“Tanaka”) and the Examiner’s statement of ordinary skill in the art.

Independent claim 1 has been amended to now recite a surge protector including “oxide films having Cr(chromium) enriched surfaces and an average thickness in the range of 0.01 to 2.0 μm .” It is respectfully submitted that the cited references, alone or in combination, do not teach or suggest at least these features of independent claim 1.

Tanaka describes a surge absorber having a glass tube sealed by two sealing electrodes made up of an alloy and a copper thin film. In asserting that Tanaka describes an oxide film having a chromium enriched surface, the Examiner states that “chromium oxide films is [sic] made in the

same process as copper oxide. Therefore, Tanaka's electrode member (11) includes oxide films with chromium enriched on surface of oxide film." October 8, 2008 Office Action, pp. 3, 5, and 7. Applicants respectfully disagree.

The presently claimed invention is directed to a surge protector including "oxide films having Cr(chromium) enriched surfaces" (emphasis added). Even if it can be conceded (which Applicants do not) that chromium oxide films and copper oxide films can be made using similar processes, this fact does not support the position that Tanaka's disclosure includes "oxide films having Cr(chromium) enriched surfaces." The mere fact that chromium oxide films and copper oxide films can be produced using similar processes is entirely irrelevant.

Further, if the Examiner is asserting that this feature of the presently claimed invention is inherent in Tanaka's disclosure, Applicants respectfully disagree. In order to establish inherency, the feature not expressly described by the reference must be necessarily present. *See* MPEP §2112. One of ordinary skill in the art would not understand oxide films having chromium enriched surfaces to be necessarily present in Tanaka's disclosure, and the Examiner's assertions are not extrinsic evidence showing that oxide films having chromium enriched surfaces is necessarily present in Tanaka's disclosure. *See* MPEP §2112.

Accordingly, for at least the reasons described above, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103(a) be withdrawn.

Claim 2 was rejected under 35 U.S.C. §103(a) as unpatentable over Tanaka in view of U.S. Patent No. 4,410,831 to Shigemori ("Shigemori").

Amended independent claim 2 recites features similar to those discussed above with respect to claim 1. Further, Shigemori does not cure the deficiencies of Tanaka. Accordingly, for at least the reasons described above, Applicants respectfully request that the rejection of claim 2 under 35 U.S.C. §103(a) be withdrawn.

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Amendment dated December 2, 2008
Reply to Final Office Action of October 6, 2008

Docket No.: 20154/0203853-US0

CONCLUSION

In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance and earnestly solicit same. If the Examiner believes there are any remaining issues which can be resolved by a Supplemental Amendment or an Examiner's Amendment, the Examiner is respectfully requested to telephone the undersigned at the telephone number indicated below.

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Respectfully submitted,

By 

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